



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,708	02/05/2002	Luke David Jagger	NAIIP314	1914
28875	7590	05/28/2009		
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			EXAMINER BILGRAMI, ASGHAR H	
			ART UNIT 2443	PAPER NUMBER
			NOTIFICATION DATE 05/28/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

anita@zilkakotab.com
erica@zilkakotab.com
dottie@zilkakotab.com

Office Action Summary

Application No.

10/072,708

Applicant(s)

JAGGER ET AL.

Examiner

ASGHAR BILGRAMI

Art Unit

2443

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 4/27/2009 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because applicant's specification does not describe what is considered to be tangible or not tangible.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 22 is rejected under 35 U.S.C. 101 because describes computer product embodied on a tangible computer readable medium. However applicant's specification on page 16. Lines 4-5 describes computer readable storage medium such as "a data signal embodied in a carrier wave" which is considered non-statutory subject matter.

6. Claims 23-26 are also rejected by virtue of their dependence on claim 22.

7. Claim 13 is rejected under 35 U.S.C. 101 because it is a system that includes software and storage medium. However, page 16. Lines 4-5 of applicant's specification describes computer readable storage medium such as "a data signal embodied in a carrier wave" which is considered non-statutory subject matter.

8. Examiner has shown one way to over come this rejection:

Specification:

Remove "a data signal embodied in a carrier wave" from the specification with a statement of disavowal for this subject matter.

Claim 22:

A computer product embodied on a tangible computer readable storage medium for generating

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1, 13 & 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to disclose the underlined portion of the limitation "reports to the hosting authority once a predetermined amount of threat information has been collected."

11. Dependent claims (i) 2-8, 10-12, 27-31 (ii) 14-21 and (iii) 23-26 are also rejected under 35 U.S.C. 112, first paragraph by virtue of their dependence on claims 1, 13 & 22 respectively.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-8 & 10-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aronson et al (U.S. 6,654,787 B1), Hall (U.S. 6,915,334 B1) and Leeds (U.S. 6,393,465 B2).

14. As per claims 1, 13 & 22 Aronson disclosed a system for generating a report on an unsolicited electronic message, the system comprising: a detector that detects a network address within an electronic message identified as an unsolicited message (col.4, lines 35-64), a host identifier that identifies an authority hosting the network address (col.4, lines 51-56 & col.5, lines 50-67); and a storage medium that at least temporarily stores the identified network address and hosting authority (col.4, lines 57-

67 & col.5, lines 1-8). However Aronson did not explicitly disclose a report generator that generates a report containing the identified network address and hosting authority. In the same field of endeavor Leeds disclosed a host identifier operable to identify an authority hosting the network address; a report generator operable to generate a report containing the identified network address and hosting authority (Leeds, Abstract, col.3, lines 54-67, col.4, lines 1-35); wherein the hosting authority comprises identifying an owner of a network domain. (col.4, lines 60-67, col.5, lines 1-44 & col.6, lines 52-65).

At the time the invention was made it would have been obvious to one in the ordinary skill in the art to incorporate the capability of generating a report of containing the address sending unsolicited message and sending that report to the hosting authority as taught by Leeds in a system of detecting unsolicited messages as taught by Aronson in order to make the unsolicited electronic mail system more versatile and robust and result in an effective way to combat unsolicited messages to a user.

However neither Aronson nor Leeds explicitly disclose transmitting the report to a central managed service provider, where the central managed service provider collects threat information from one or more organizations and reports to the hosting authority once a predetermined amount of threat information has been collected.

In the same field of endeavor Hall disclosed transmitting the report to a central managed service provider, where the central managed service provider collects threat

information from one or more organizations and reports to the hosting authority once a predetermined amount of threat information has been collected (col.10, lines 1-12) {Hall mentions collection of the SPAM list from users at a central server and then making the SPAM list globally available to users. If the list can be made globally available to users as Hall suggested then it can just as easily be made available to one or more hosting authorities (I.E. Internet Service Provider) to curtail the SPAM associated with SPAM list.}

It would have been obvious to one in the ordinary skill in the art at the time the invention was made to have incorporated transmitting the report to a central managed service provider, where the central managed service provider collects threat information from one or more organizations and reports to the hosting authority once a predetermined amount of threat information has been collected as disclose by Hall in the system of detecting unsolicited messages as taught Aronson and Leeds in order to make the system robust by reducing not only the amount of unsolicited messages received by the user but also the reducing the source(s) of the unsolicited messages.

15. As per claims 2, 11, 17-19 & 24 Aronson-Leeds and Hall disclosed the method of claim 1 wherein the central managed service provider configured to forward, the report to the identified hosting authority (Leeds, col.4, lines 36-67, col.5, lines 1-44 & col.8, lines 34-57).

16. As per claims 3, 14 & 15 Aronson-Leeds and Hall disclosed the method of claim 1 wherein examining the message to identify a network address comprises identifying a URL (Aronson, col.5, lines 50-67).

17. As per claims 4, 20 & 25 Aronson-Leeds and Hall disclosed the method of claim 3 wherein identifying a URL comprises comparing text within the electronic message to a database of words to identify the URL (Aronson, col.4, lines 57-67, col.5, lines 1-8 & col.5, lines 50-67).

18. As per claims 5, 21 & 26 Aronson-Leeds and Hall disclosed the method of claim 3 further comprising comparing the identified URL to a database of legitimate URLs (Aronson, col.4, lines 57-67, col.5, lines 1-8 & col.5, lines 50-67).

19. As per claim 6 Aronson-Leeds and Hall disclosed the method of claim 5 further comprising updating the database based on electronic messages received (Aronson, col.6, lines 1-9).

20. As per claim 7 Aronson-Leeds and Hall disclosed the method of claim 3 wherein identifying the hosting authority comprises utilizing an Internet tool to locate a web server hosting the URL (Leeds, col.3, lines 54-67, col.4, lines 1-23, col.4, lines 60-67 & col.5, lines 1-44).

21. As per claim 8 Aronson-Leeds and Hall disclosed the method of claim 7 wherein utilizing an Internet tool comprises utilizing WHOIS (Leeds, col.5, lines 21-25).

22. As per claims 10 & 16 Aronson-Leeds and Hall disclosed the method of claim 1 wherein identifying the hosting authority comprises identifying an Internet service provider (Leeds, col.3, lines 54-67, col.4, lines 1-23, col.4, lines 60-67& col.5, lines 1-44).

23. As per claim 12 Aronson-Leeds and Hall disclosed the method of claim 1 further comprising at least temporarily saving the report and transmitting the report to the identified hosting authority at the end of a specified period (Leeds, col.5, lines 38-44)

24. As per claim 23 Aronson-Leeds and Hall disclosed the computer product of claim 22 wherein the computer readable medium is selected from the group consisting of CD-ROM, floppy disk, tape, flash memory, system memory and hard drive (Leeds, col.3, lines 10-36).

25. As per claim 27, 28, 29, 30 & 31 Aronson-Leeds and Hall disclosed the method of claim 1 wherein identifying the hosting authority further comprises identifying an address, an administrative contact name, an administrative contact telephone number, and name of at least one server associated with the hosting authority (Leeds, col.4, lines 37-67 & col.5, lines 1-44).

Response to Arguments

26. Applicant's arguments with respect to amended claim 1-8, 10-31 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

28. Schiavone et al (U.S. Pub. No. 2002/0120705 A1) disclosed system and method for controlling distribution of network communication.

29. Hart (U.S. Pub. No. 2002/0116463 A1) disclosed unwanted E-mail filtering.

30. Neilson (U.S. 6,453,327 B1) disclosed Method and apparatus for identifying and discarding junk electronic mail.

31. Gough et al (U.S. 6,687, 740 B1) disclosed system, method and article of manufacture for preventing the proliferation of unwanted electronic messages.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASGHAR BILGRAMI whose telephone number is (571)272-3907. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia L.M. Dollinger can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. B./
Examiner, Art Unit 2443

/J Bret Dennison/
Primary Examiner, Art Unit 2443